

### **REMARKS**

Claims 1-3, 5-9, 11-16, 18 and 19 are all of the pending claims, with claims 1, 7 and 14 being written in independent form. By virtue of this Amendment, Applicant cancels claims 4, 10 and 17.

The Examiner rejects claims 1-19 under 35 U.S.C. §103(a) as being obvious over US 5,267,434 to Termuehlen et al. ("Termuehlen"). Applicant respectfully traverses this rejection in view of the following remarks.

As a preliminary matter, Applicant cancels claims 4, 10 and 17, without prejudice or disclaimer, thereby rendering the rejection of these claims moot.

#### **A. Independent claim 1:**

Independent claim 1 recites (among other things) that the chimney orifice (of the transition piece) is a flow duct that is "*shorter than a vertical height of the transition piece.*" Example, non-limiting embodiments of this feature are discussed throughout the instant specification. For example, paragraph [0015] indicates that the chimney orifice is designed as a flow duct that may be shorter than the vertical extent of the transition piece. This paragraph goes on to explain that by virtue of this feature, the flow duct may be easily produced and easily integrated as a chimney orifice on the transition piece. The Examiner's attention is also respectfully direct to the figure of the instant application. Here, the chimney orifice 13 is shorter than the vertical height of the transition piece 7. At least the "*chimney orifice*" feature (as recited in independent claim 1), in combination with the other features recited in independent claim 1, is not taught or suggested by the prior art relied upon by the Examiner.

The Examiner looks to the Termuehlen reference to teach each and every feature defined by claim 1. In so doing, the Examiner relies heavily upon the embodiment depicted in Figs. 1-3. Applicant respectfully disagrees.

As clearly shown in Fig. 2(B) of the Termuehlen reference, the auxiliary stack 14 (apparently compared by the Examiner to the claimed chimney orifice) extends to a total height of 125 feet, while the structure supporting the auxiliary stack 14 extends to a height of about 20 feet. That is, at least based on the dimensions indicated in Fig. 2(B), the auxiliary stack 14 has a height of about 105 feet, which is far greater than the 20 foot height of the structure supporting the auxiliary

stack 14. Certainly then, the auxiliary stack 14 is not shorter than a vertical height of the structure supporting the auxiliary stack 14.

The Examiner apparently recognizes the shortcoming noted above, and therefore summarily concludes that the height of the auxiliary stack 14 is an obvious matter of design choice because the claimed chimney accommodates a flow that is pushed through it under pressure by the gas turbine. Applicant still believes that the Examiner has not established a *prima facie* case of obviousness.

It is well settled that the Examiner bears the initial burden of factually supporting a *prima facie* case of obviousness. Such factual support includes pointing out some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference.<sup>1</sup> The Examiner has simply not carried this initial burden.

Specifically, the Examiner reasons that the alleged height of the auxiliary stack 14 would have been obvious because the auxiliary stack 14 accommodates a flow that is pushed through it under pressure by the gas turbine. However, this line of reasoning amounts to nothing more than an “obvious to try” rational. An “obvious to try” rational is not a proper basis for an obviousness rejection. MPEP 2143.01 even explains that the mere fact that a reference can be modified does not render the result and combination obvious, unless the prior art also suggests the desirability of the modification. If the Examiner maintains this rejection, then he should at least point out (with specificity) why the alleged height of the auxiliary stack 14 would have been desirable. Without this specific information, the Examiner’s articulated motivation appears to be based on an impermissible hindsight of Applicant’s disclosure.

**B. Independent claims 7 and 14:**

Independent claim 7 and 14 are somewhat similar to claim 1 to the extent that they recite that the chimney orifice is a flow duct that is “*shorter than a vertical height of the transition piece.*” Accordingly, Applicants respectfully submits that claims 7 and 14 are patentable for reasons analogous to those noted above with respect to independent claim 1.

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<sup>1</sup> MPEP 2143.

**CONCLUSION**

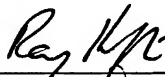
In view of the above, Applicant earnestly solicits reconsideration and allowance of each of claims 1-3, 5-9, 11-16, 18 and 19.

Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

By   
Ray Hedin  
Reg. No. 41,060  
P.O. Box 8910  
Reston, VA 20195  
(703) 668-8000

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